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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,702	01/28/2004	Longin B. Greszczuk	024.0127 (03-1192)	3817

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1755

MAIL DATE	DELIVERY MODE
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05/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/766,702	GRESZCZUK, LONGIN B.	
	Examiner	Art Unit	
	David M. Brunsman	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-35, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-35, 39, 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's response filed 08 March 2007 has been carefully considered. Applicant's arguments are addressed below.

With respect to the water barrier vs. water vapor issue, the instant claims are not limited to solely reducing water vapor transmission. Nor, does the website pointed to include evidence that one of ordinary skill in the art would read the instant application as limited to solely preventing water vapor transmission or the prior art relied upon to allowing it. Finally, applicant's reliance on the URL of a website which is transitory in nature is strongly discouraged.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-35, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase "without need to apply heat to the composition or substrate surface" is not supported by the original specification. Paragraph [24] addresses the application of the coating composition to a substrate. The use of solvent borne compositions is dismissed as "disfavored" and producing "pinholes" in the resulting coating, clearly contrary to the required characteristics of the instant claims. The claims themselves explicitly recite "heating and blending...". The only other coating methods disclosed require liquefying by heating for application. One of ordinary skill in the art is not taught what method, not requiring heating of the composition or substrate would be effective to achieve the basic and novel characteristics of the invention. Applicant's reliance on MPEP 2163.07(a) is not persuasive as applicant has not established inherency by showing that "the extrinsic evidence must make clear that the missing descriptive matter would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities of possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 49 USPQ2d 1949.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-24 and 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 1333057.

The reference teaches a "Composition of Matter for Treating Concrete (a composite of cement and aggregate) Flooring" that can be applied by a brush (page 2, line 12) comprising 60 parts paraffin wax (C₂₅₋₃₀ paraffins, having a melting point of about 120-160 F), 15 parts beeswax (fatty acid esters, having a melting point of about 149 F), 15 parts carnauba wax (fatty acid esters, having a melting point of about 187 F) and, 12 parts coloring matter such as chromium oxide. See page 1, lines 70-75. No bubbles are disclosed in the finished mixture. Nor, does applicant provide evidence that there are or would be expected. The reference does not disclose the melting point of the waxes mixed of the melting point of the entire mixture. The rule of mixtures predicts that the melting point of the mixture would be about $(.6(160) + .15(149) + .15(187))/0.9 = 163$ F. In combination with the application temperature of the mixture of 212 F (page 2, line 8), it is considered that the melting point of the mixture would fall within the range of *about* 170-190 F. No criticality for compositions exactly falling within the narrow range of 170-190 F is demonstrated in the instant application. The description of the composition coating and **sealing** to a depth of ½ inch with the clearly hydrophobic waxes indicates a reduction in moisture absorption. The reference does not explicitly recite the degree of reduction. However, the similar ingredients employed and manner of use would be expected to exhibit similar physical properties. If the only alleged distinction[s] is[are] recited in functional language, the burden is on applicant to show the reference does not possess such characteristics. *In re Ludtke*, 169 USPQ 563. Argument that the reference does not is not a showing. Whether it is incursion of water vapor, liquid water or both, any would be functional language that would require such a showing.

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Applicant's response argues the prior art is missing three critical limitations set forth in the instant claims. 1) Annan does not address the presence of entrained gasses in the composition. There is no evidence of record that said gasses are present. The fact that the reference composition is effective as a sealant and applicant has indicated entrained gases would prevent effective sealing is evidence of the substantial lack of entrained gas in the composition of the reference. Furthermore, there is no enabling disclosure in the instant specification, as originally filed, that would teach one of ordinary skill in the art how to predict or determine, without undue experimentation, those combinations of various binders, fillers, particle sizes and proportions that would exhibit the basic and novel characteristics of the invention. The lack of such disclosure has been taken as indicating almost any such combination would exhibit those characteristics. Applicant has not identified any evidence to the contrary. 2) The limitations to the claim that heat need not be applied does not exclude compositions wherein the exemplified use applies heat. Furthermore, as set forth above, the application of the composition of the instant claims without additional heating is not enabled by the instant specification. 3) The disclosure of Annan is directed to its use as a sealant, indicating moisture incursion is prevented. Further, the similar compositions employed would be expected to exhibit similar properties. A composition's properties are inalienable from the composition itself. Finally an argument that the similar compositions of the prior art do not exhibit the desired properties presupposes, a critical difference in the composition itself, not recited in the instant claims and without sufficient teaching in the specification as originally filed to allow one of ordinary skill to determine which particular combinations possess that critical difference.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-28, 34, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 1333057, as applied above, in view of US Patent 5106415.

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The difference between US 1333057 and the instant claims is the recitation of the dispersed powder as aluminum metal (comprising particulates of the size 25-60 microns) or titanium dioxide. US 5106415 teaches a formulation for a wax-based protective coating comprising a powder component of a filler such as 25-150 micron aluminum powder and/or a pigment such as titanium dioxide. (See column 3, lines 3-10, 37-38). It would have been obvious to one of ordinary skill in the art to substitute the aluminum powder or titanium dioxide of US 5106415 for the chromium oxide of 1333057 because the secondary reference teaches they are useful in similar wax-based applications.

The secondary reference teaches the titania and aluminum pigments recited in the instant claims are useful as coloring agents in wax-based coating compositions. There is no evidence of record that the coloring properties of the pigment are reliant or would be expected to be reliant upon the manner by which the wax composition is intended to be applied. Applicant's response cites the MPEP for three possible sources of motivation to combine references. The combination proposed by examiner meets all three. The nature of the problem to be solved in each reference is how to color a wax composition, Annan's teaching pigments such as chromic oxide are effective and Davidian's teaching pigments such as titania and aluminum are. The secondary reference clearly teaches that aluminum and titanium pigments are useful for coloring wax-based coating compositions and as such the addition of a pigment such as the titania or aluminum recited is taught by the prior art secondary reference and effective to color wax-based coatings. Physical incorporation of the compositions of the Annan and Davidian references is not required only application of what Davidian teaches one of ordinary skill in the art to the invention of Annan.

With respect to the rejections under section 103, applicant argues that the examiner has not established a proper *prima facie* case of obviousness. To the contrary, examiner has not relied simply on isolated disclosures showing various components as being known in the art but, provided clear and convincing reasoning why one of ordinary skill in the art would be motivated to make the modifications suggested even if the reasons relied upon differ from those reasons put forth in the instant application. A different reason is not a "mistaken" one. A patent cannot be granted for the discovery of a result, even though it may be unexpected good, which would flow logically from the

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teaching of the prior art." See *In re Rau*, 117 USPQ 215; *Ex Parte Raychem Corp.*, 17 USPQ2d 1417; *In re Litner*, 173 USPQ 260.

Applicant argues that the claimed particles are necessary to permit uniform heating of the mixture and exclusion of gases, pointed to paragraph 0023 of the specification. This paragraph discloses these advantages are achieved by addition of a powdered inorganic material in general, they do not require the specific species of 25-60 micron aluminum or titanium dioxide. The provision of powdered inorganic material is anticipated by Annan. The advantages to using aluminum powder set forth in the first paragraph of page 12 of the response are without basis in the specification or any other part of the record. There is no requirement the reasonable likelihood of success indicative of obviousness be limited to only the problem explicitly addressed by applicant. One may be motivated to arrive at the claimed invention for additional reasons.

The rejection of record includes all of the claimed features of the invention including those discussed with reference to Annan.

Claims 22-35, 39 and 40 are of this application conflict with claims 21-34 and 37-39 of Application No. 10/816384. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 22-28, 31-33 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 21-27, 30-32, respectively, of copending Application No. 10816384. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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The instant claims above differ from the prior art only in the recited intended use and the intrinsic physical property of reduced moisture loss in the intended use. While this property may be best measured during the intended use, the similar compositions employed by the other application would be expected to possess the same physical properties. There is no evidence of record that the compositions claimed in either application are materially limited by the recitation of intended use.

With respect to the rejections under section 101 (double patenting), this application and 10/816384 are properly subject to double patenting. The claims at issue are drawn to a composition. The intended use or effects of that composition do not change the nature of the composition itself. Applicant's argument with respect to intended direction of moisture transport of each set of claims has been fully addressed previously

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-28, 31-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-27, 30-32, respectively, of copending Application No. 10/816384. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the recited use. One of ordinary skill in this art understanding the basic chemical and engineering principles of the art and would recognize that a composition designed to seal a porous surface and prevent water absorption thereby would prevent water transport at either interface likewise preventing water loss from a moist substrate. See, *ex Parte Hiyamizu*, 10 USPQ2d 1393.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claims 29 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of copending Application No. 10/816384. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 29 differs in the range of the melting point of the wax/paraffin mixture. The ranges overlap between 120 F and 200 F. Without a showing of criticality or unexpected results for the difference in the ranges, product claims having overlapping numerical ranges would have been obvious to one of ordinary skill in the art. *In re Malagari*, 182 USPQ 549.

Claims 30, 34, 35, 39 and 40 of the instant application differ from claims 29, 33, 34 and 37-39 of the 10/816384 application in the range at which the mixture of fatty acid esters and hydrocarbons melt/soften. The ranges overlap between 170 F and 180 and a softening point overlapping at ,120 F in instant claims 30 and 39 as compared to claims 29 and 38 of 10/816384. Without a showing of criticality or unexpected results for the difference in the ranges, product claims having overlapping numerical ranges would have been obvious to one of ordinary skill in the art. *In re Malagari*, 182 USPQ 549.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, Th, F, Sa; 7:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David M Brunsman
Primary Examiner
Art Unit 1755

DMB

A handwritten signature in dark ink, appearing to read 'David M Brunsman', is written over the printed name and title.